



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,708	02/25/2002	Norihisa Takayama	030682-110	8418
<div>7590 11/06/2009</div> <div>Platon N. Mandros</div> <div>BURNS, DOANE, SWECKER & MATHIS, L.L.P.</div> <div>P.O. Box 1404</div> <div>Alexandria, VA 22313-1404</div>				
<div>EXAMINER</div> <div>NICKERSON, JEFFREY L.</div>				
ART UNIT		PAPER NUMBER		
2442				
MAIL DATE		DELIVERY MODE		
11/06/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/080,708

Applicant(s)

TAKAYAMA, NORIHISA

Examiner

JEFFREY NICKERSON

Art Unit

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :
10 April 2002, 08 May 2003, 12 September 2003.

DETAILED ACTION

1. This communication is in response to Application No. 10/080,708 filed 25 February 2002. The restriction response presented on 14 August 2009, which elects group III (claims 12-13, 17-18) with traversal arguments, and amends claims 3-9, and 11, is hereby acknowledged. Claims 1-26 are currently pending.

Election/Restrictions

2. The election response filed 14 August 2009, providing changes to claims 3-9 and 11 that incorporate the subcombinations into the combination, is noted and the traversal arguments have been fully considered. Applicant's arguments are persuasive and the restriction requirement is hereby withdrawn, *in whole*, and all pending claims are rejoined with group III.

Information Disclosure Statement

3. The information disclosure statement filed on 08 May 2003 by applicant may have one or more references crossed-off due to a failure to comply with the provisions of 37 CFR 1.98(a)(2), because of a lack of a legible copy for one or more cited non-patent literature documents or foreign patent document. The IDS has been placed in the application file, but the crossed-off documents referred to therein have not been considered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 19-26, these claims contain the transitional phrases "which comprises", however there is ambiguity as to which item the "which" is referring to, and thus who is doing the comprising. For claims 19-24, is the computer program comprising, or is the apparatus comprising? For claims 25-26, is the program comprising or the apparatus comprising? Clarification is required. See also 101 issues below.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Method claims 14-18 are being interpreted as being tied to at least one particular machine based on applicant's definition of "terminal" (applicant submitted specification: paragraph [0037]).

8. Claims 19-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 19-24, these claims are each directed towards a "computer program", which is software, as indicated by applicant (applicant submitted specification: [0056]). Claims directed to software, *per se*, are non-statutory. Furthermore, the bodies of these claims appear to be directed towards components of an apparatus and thus the computer program comprises nothing. Clarification is required.

Regarding claims 25-26, these claims are each directed towards "a recording medium." A claim directed towards a "medium", is not statutory if applicant does not specifically define the phrase in their specification as being only non-transitory mediums. The phrase therefore encompasses mediums such as signal waves over air or water, which is non-statutory subject matter (Applicant submitted specification: [0054] "*and the like*"), and the claims are therefore directed to non-statutory embodiments. Furthermore, the bodies of these claims appear to be directed towards components of an apparatus and thus there is ambiguity as to which statutory class is being claimed. Beauregard claims generally require the body of the claim to be a process. Clarification is required.

Claim Rejections – 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6, 9-10, 12-21, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teibel (US 6,366,962 B1), and in further view of Appelman et al (US 6,539,421 B1).

Regarding claim 12, Teibel teaches a system capable of transmitting data via a network (Teibel: Figure 1), the system comprising:

a) a data receiving apparatus (the second client) including:

a generator for generating information representing whether or not said data receiving apparatus itself is ready for receiving data (Teibel: Figure 2, steps 210-220; col 4, lines 21-37 provides awareness information is generated when client comes online; see also col 6, lines 38-58); and

a sender for sending said information generated by said generator to said network at least when said data receiving apparatus itself becomes ready for receiving data or becomes no longer ready for receiving data independently of receiving a send request via send network (Teibel: col 4, lines 21-37; col 6, lines 38-58 provide transferring state updates every time state changes); and

b) a data sending apparatus (the first client) including:

a receiver for receiving from said data receiving apparatus said information representing whether or not said data receiving apparatus is ready for receiving data via said network (Teibel: col 7, line 52 – col 8, line 5 provide for receiving awareness signals);

a register for registering destinations of data sending via said network (Teibel: col 7, lines 39-51 provide for an active destination list);

an interface for enabling a user to select a data send destination from said destinations registered in said register (Teibel: col 7, lines 39-51 provide for active buddy list; col 5, lines 11-19 provide this is for lms, etc; Figure 3);

a sender for sending data to said data send destination selected by said user via said interface (Teibel: col 5, lines 11-19 provide this is for lms, etc);

and a controller for controlling said interface so as to manage said data send destinations on a the basis of said information received from said receiver (Teibel: col 7, lines 39-51 provide for maintaining list of only active/online users).

Teibel does not explicitly recite that said interface is controlled so as to limit selection of said data send destinations by said user on the basis of said state information.

Appelman, in a similar field of endeavor, teaches wherein said interface is controlled so as to limit selection of said data send destinations by said user on the basis of said state information (Appelman: Figure 4; col 2, lines 20-30 provides buddy list limits to only those that are currently online).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Appelman for limiting selection of destinations to only those currently online. The teachings of Appelman, when implemented in the Teibel system, will allow one of ordinary skill in the art to limit destination selections based on received state information. One of ordinary skill in the art would be motivated to utilize the teachings of Appelman in the Teibel system in order to ease user management of potential destinations.

Regarding claim 13, the Teibel/Appelman system teaches wherein said controller controls said interface so that only said terminal that is ready for receiving data is made to be selectable by said user as said data send destination (Appelman: Figure 4).

Regarding claim 3, the Teibel/Appelman system teaches wherein the system includes plural data receiving apparatuses (Teibel: Figure 7; col 4, lines 21-38; col 6, lines 38-58), and

wherein said controller of the data sending apparatus registers a first data receiving apparatus that becomes ready for receiving data in said register as a destination of data sending and cancels registration of a second data receiving apparatus that becomes no longer ready for receiving data, on the basis of information received by said receiver (Teibel: col 4, lines 21-38; col 6, lines 38-58).

Regarding claim 4, the Teibel/Appelman system teaches wherein said interface of the data sending apparatus includes a display for displaying said destinations (Appelman: Figure 4).

Regarding claim 5, the Teibel/Appelman system teaches wherein the system includes plural data receiving apparatus (Teibel: Figure 7; col 4, lines 21-38; col 6, lines 38-58), and

wherein said controller controls said interface, on the basis of said information received by said receiver, so that a first data receiving apparatus that is ready for receiving data is displayed on said display as a destination, and a second data receiving apparatus which is not ready for receiving data is not displayed (Appelman: Figure 4; col 2, lines 20-30 provides buddy list only displays currently online buddies).

Regarding claim 6, the Teibel/Appelman system teaches wherein said system includes plural data receiving apparatuses (Teibel: Figure 7; col 4, lines 21-38; col 6, lines 38-58), and

wherein said controller controls said interface, on the basis of said information received by said receiver, so that a first data receiving apparatus that becomes ready for receiving data is registered in said register as said destination, and registration of a second data receiving apparatus that becomes no longer ready for receiving data is canceled, and only said destinations that are registered in said register are displayed on said display (Teibel: Figures 7-8; col 4, lines 21-37 and col 6, lines 38-58 provide for

maintaining active/online list; Appelman: Figure 4; col 2, lines 20-30 for displaying only active/online).

Regarding claim 9, the Teibel/Appelman system teaches wherein the data sending apparatus further comprises a reader for reading an image of a document to acquire image data (Teibel: Figure 3, item 390); and

wherein said sender can send said image data that has been read by said reader (Teibel: col 5, lines 11-19).

Regarding claim 1, this apparatus claim contains limitations found within that of claim 12 and the same rationale of rejection is used, where applicable.

Regarding claim 2, this apparatus claim contains limitations found within that of claim 13 and the same rationale of rejection is used, where applicable.

Regarding claim 10, this apparatus claim contains limitations found within that of claim 12 and the same rationale of rejection is used, where applicable.

Regarding claim 14, this method claim contains limitations found within that of claim 12, and the same rationale of rejection is used, where applicable.

Regarding claim 15, this method claim contains limitations found within that of claim 13, and the same rationale of rejection is used, where applicable.

Regarding claim 16, this method claim contains limitations found within that of claim 12, and the same rationale of rejection is used, where applicable.

Regarding claim 17, this method claim contains limitations found within that of claim 12, and the same rationale of rejection is used, where applicable.

Regarding claim 18, this method claim contains limitations found within that of claim 13, and the same rationale of rejection is used, where applicable.

Regarding claim 19, this computer program claim contains limitations found within that of claim 12, and the same rationale of rejection is used, where applicable.

Regarding claim 20, this computer program claim contains limitations found within that of claim 13, and the same rationale of rejection is used, where applicable.

Regarding claim 21, this computer program claim contains limitations found within that of claim 5, and the same rationale of rejection is used, where applicable.

Regarding claim 24, this computer program claim contains limitations found within that of claim 12, and the same rationale of rejection is used, where applicable.

Regarding claim 25, this recording medium claim contains limitations found within that of claim 12, and the same rationale of rejection is used, where applicable.

Regarding claim 26, this recording medium claim contains limitations found within that of claim 12, and the same rationale of rejection is used, where applicable.

11. Claims 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teibel (US 6,366,962 B1), in view of Appelman et al (US 6,539,421 B1), and in further view of Armstrong (US 2004/0039779 A1).

Regarding claim 7, the Teibel/Appelman system teaches wherein said system includes plural data receiving apparatuses (Teibel: Figure 7; col 4, lines 21-38; col 6, lines 38-58), and

wherein said controller controls said interface, on the basis of said information received by said receiver, so that a first data receiving apparatus that is ready for receiving data and said data receiving apparatus that is not ready for receiving data are differentiated in the display (Teibel: Figures 7-8; col 4, lines 21-37 and col 6, lines 38-58 provide for maintaining active/online list; Appelman: Figure 4; col 2, lines 20-30 for displaying active/online and lack of displaying nonactive/offline).

The Teibel/Appelman system does not explicitly recite wherein the display differentiating is displaying in different forms.

Amstrong, in a similar field of endeavor, teaches wherein the display differentiating is displaying in different forms (Amstrong: Figures 15a-17; [0099]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Armstrong for being capable of seeing all buddies both offline and online and visually distinguishing between the two. The teachings of Armstrong, when implemented in the Teibel/Appelman system, will allow one of ordinary skill in the art to visually distinguish between online/offline buddies based on status information received. One of ordinary skill in the art would be motivated to utilize the teachings of Armstrong in the Teibel/Appelman system in order to provide users with more buddy list configuration options and to make user interaction easier.

Regarding claim 22, this computer program claim contains limitations found within that of claim 7 and the same rationale of rejection is used, where applicable.

12. Claims 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teibel (US 6,366,962 B1), in view of Appelman et al (US 6,539,421 B1) and Armstrong (US 2004/0039779 A1), and in further view of Wick (US 6,691,162 B1).

Regarding claim 8, the Teibel/Appelman/Amstrong system does not teach wherein said controller controls said sender so that when said data receiving apparatus that is not

ready for receiving data is selected by said user as said data send destination via said interface, data is sent after said data receiving apparatus becomes ready for receiving data.

Wick, in a similar field of endeavor, teaches wherein said controller controls said sender so that when said data receiving apparatus that is not ready for receiving data is selected by said user as said data send destination via said interface, data is sent after said data receiving apparatus becomes ready for receiving data (Wick: Figure 5; abstract; col 5, lines 7-23 provides for sending triggered by target sign-on).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Wick for queuing messages for offline buddies to be sent as soon as they come online. The teachings of Wick, when implemented in the Teibel/Appelman/Amstrong system, will allow one of ordinary skill in the art to queue messages for offline buddies. One of ordinary skill in the art would be motivated to utilize the teachings of Wick in the Teibel/Appelman/Amstrong system in order to provide users with more buddy communication options and to make user interaction easier.

Regarding claim 23, this computer program claim contains limitations found within that of claim 8 and the same rationale of rejection is used, where applicable.

13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teibel (US 6,366,962 B1), in view of Appelman et al (US 6,539,421 B1), and in further view of Horvitz et al (US 7,249,159 B1).

Regarding claim 11, the Teibel/Appelman system does not teach wherein said sender further sends said information generated by said generator regularly at a predetermined time interval.

Horvitz, in a similar field of endeavor, teaches wherein said sender further sends said information generated by said generator regularly at a predetermined time interval (Horvitz: col 9, lines 16-43 provide for heartbeat messaging).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Horvitz for heartbeat status updating. The teachings of Horvitz, when implemented in the Teibel/Appelman system, will allow one of ordinary skill in the art to identify status changes based on heartbeat messages. One of ordinary skill in the art would be motivated to utilize the teachings of Horvitz in the Teibel/Appelman system in order to more reliably identify significant status changes.

Citation of Pertinent Prior Art

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Gase et al (US 5,580,177) discloses a printer management system with printer status indicators viewable by job assigning users.
- b. Pelkey et al (US 2006/0121986 A1; (US 7,056,217 B1) discloses a messaging service with status viewability.
- c. Whitten, II (US 2002/0083136 A1) discloses a system for filtering buddy lists based on variable inputs, including destination status.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY NICKERSON whose telephone number is (571)270-3631. The examiner can normally be reached on M-Th, 9:00am - 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. N./
Examiner, Art Unit 2442

**/Asad M Nawaz/
Primary Examiner, Art Unit 2455**